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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,644

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Dimitri J. Stephanou

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EXAMINER

RAVETTI, DANTE

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,644	<b>Applicant(s)</b> STEPHANOU, DIMITRI J.	
	<b>Examiner</b> DANTE RAVETTI	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Acknowledgements**

1. This communication is in response to the amended Application No. 10/710,644 filed on 5 May 2008.
2. Claims 1-18 are currently pending and have been fully examined.
3. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

### **Response to Amendments/Arguments**

4. Applicant's argument filed on 5 May 2008, have been fully considered, but they are not persuasive. Applicant argues that Flesner fails to teach, "a plurality of client files...a plurality of customer files...a plurality of expert files...." and lacks claimed "instructions for allowing and administrator...to supply data..." Further, Applicant is of the opinion that the newly added language is sufficient for distinguishing the claims from the prior art. The Examiner respectfully disagrees.
5. As to claims 1-18, these claims describes functional and intended use language and does not further limit the scope of the claims.

Claim 1, has been amended to further describe:

"a plurality of software business solution files;

a plurality of client files comprising data for customizing a software business solution for a client;

a plurality of client customer files comprising customer information for each customer of each client;

a plurality of expert files comprising customer representative information for each client;

login information associated with a user;

instructions for serving a customized business solution to the user over the network upon login, wherein the business solution is customized based on an associated software business solution file, an associated client file, and at least one of a group selected from an associated client customer file and an associated expert file; and

instructions for allowing an administrator for a client to supply data to a client file, customer information for customer files, and information for expert files over the network;"

However, "a plurality of software...files; a plurality of client files...data...; a plurality of client customer files...information...; a plurality of expert files...information...; login information ...user;" is representative of non-functional descriptive information and it has been held such information will not distinguish a claimed system from the prior art.<sup>1</sup> Applicant recites, "instructions for serving..." and "instructions for allowing...;" however, this language is intended use and it has been held that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed system from the prior art-if the prior art has the capability to so perform.<sup>2</sup> In addition, the instruction stored in media are non-functional descriptive material and it has been held that non-functional descriptive material stored in memory will not differentiate a claimed memory from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

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<sup>1</sup> *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II; Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate

<sup>2</sup> MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987); A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art-if the prior art has the capability to so perform.

Claims 2-18 also contain similar language and contains similar deficiencies. The appropriate correction is required.

**Claim Rejections - 35 USC § 101**

6. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-18 are rejected under 35 U.S.C §101, because the claimed invention is directed to non-statutory matter (the claimed subject matter is not within one of the four statutory classes). Claim 1 appears to be a Hybrid claim (a claim containing mixed subject matter) (see MPEP §2173.05(p) II). The appropriate correction is required.

As to claims 2-6, 8, 10-18 are also rejected as each recites similar language.

Claims 7 and 9 are also rejected as being dependent upon rejected claims.

**Claim Rejections - 35 USC § 112, 2<sup>nd</sup>**

7. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-18 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> Par. as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, that are considered to be Hybrid claim since a person of ordinary skill in the art would recognize that the claim encompasses as least two statutory classes of invention (a claim containing a mixed subject matter) (see MPEP §2173.05(p) II).

Evidence that claim 1 recites a system includes: The Preamble ("A system for Allowing customization of software business solutions...."), dependent claim 2 which begins, "The system for allowing customization of claim 1,...."

Here Applicant seems to be combining a system claim with a method claim (set of instructions) (e.g. "...instructions for serving a customized business solution...instructions for allowing and administrator...instructions for allowing the administrator...." Because of the conflicting evidence, the claim is considered a Hybrid claim and the appropriate correction is required.

Also, "instructions for serving a customized business...instructions for allowing and administrator..." would not be clear to one of ordinary skill in the art, thereby rendering their scope of the claim(s) unascertainable. See MPEP §2173(d).

As to claims 2-6, 8-18 are also rejected as each recites similar language. The appropriate correction is required.

**Claim Rejections -35 U.S.C. §102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 - 11 are rejected under 35 U.S.C. §102(b) as being anticipated by Flesner et al., (US 2002/0194267)("Flesner").

**As to claim 1:**

Flesner discloses the invention as claimed, a system for generating and running custom-built soft-ware business solutions:

- a. a server further comprising a file of software business solutions (see at least the Abstract; page 1, par. [08]; page 3, par. [037] and [039]);
- b. a network connected to the server for allowing access to the file of software business solutions (see at least page 1, par. [011], [012] and [015]);
- c. at least one user computer connected to the network of the system for selecting and customizing one or more software business solutions (see at least the Abstract; page 1, par. [07], [09], [010]; page 3, par. [035]);
- d. the server further comprising customization instructions adapted to customize the software business solutions to the user's needs in a series of few steps (see at least page 1, par. [01] (streamlines the process));
- e. the server further comprising a file of customization specific to each user (see at least page 3, par. [036] (associated with sponsor); page 6, par. [101]; page 10, par. [168] and [170]);
- f. the software business solutions further comprising instructions to link users upon login to their own customization files (see at least page 8, par. [135]-[140]);

**As to claim 2:**

wherein the server allows the user of the system to add Information about the organization the user is coming from to include the name and address of the

organization in the file of clients (see at least page 1, par. [05]-[06]; page 3, par. [036]; page 6, par. [091]);

**As to claim 3:**

wherein the server further comprises instructions adapted to allow the client to select a business solution from a list of several business software solutions (see at least page 3, par [036] (navigation buttons or links) - [037]);

**As to claim 4:**

wherein the server further comprises instructions adapted to allow the client to add information about the looks of the business solution to include the client organization's logo (see at least page 3, par. [036]);

**As to claim 5:**

wherein the server further comprises instructions adapted to allow the client to customize the screen label name for the data fields of the business solution (see at least page 3, par. [036], [037]; page 4, par. [059], [063]);

**As to claim 6:**

wherein the server further comprises instructions adapted to allow the client to customize the text fields used by the business solution to generate communication messages (see at least page 7, par. [102]; page 9, par. [157]-[166]);

**As to claim 7:**



wherein the server further comprises instructions adapted to allow the client to assign an administrator for the business solution by entering information to include name, userid, password and contact information (see at least page 8, par. [136]);

**As to claim 8:**

wherein the server further comprises instructions adapted to allow the system to display a summary of customizations that the user has performed at the end of each of the customization steps (see at least page 10, par. [178]-[179]);

**As to claim 9:**

wherein the server further comprises instructions adapted to allow the user to login as the administrator in order to continue with the additional customization steps (see at least the Abstract; page 4, par. [049]; page 6, par. [102]);

**As to claim 10:**

wherein the server further comprises instructions adapted to allow the administrator to add other users to the file of users and assign login and contact information for those users (see at least page 9, par. [136]);

**As to claim 11:**

wherein the server further comprises instructions adapted to allow the administrator to assign administrator privileges to one or more users being added to the file of users (see at least page 6, par. [101]-[103]; and page 7, [par. 105]);

**Claim Rejection 35 USC §103**

11. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all

obviousness rejections set forth in this office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in 35 U.S.C. §102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 12, 15 - 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Flesner, in view of Budka et al., (US 2003/0131317) ("Budka").

**As to claim 12:**

Flesner does not expressly disclose the limitation of:

a server further comprises instructions adapted to allow the system to display a check mark next to each customization step when it is completed;

However, Budka discloses this limitation at least on page 3, par. [021]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Flesner to include the features of Budka because check marking is an easy and cost effect method of indication to the user.

**As to claim 15:**

Flesner does not expressly disclose the limitation of:

server further comprises instructions adapted to allow the administrator to add experts to a list to be resident on the file of experts; and

assign information for the experts to include login and contact information, expertise level and attaching a resume for those experts.

However, Budka discloses this limitation at least on page 3, par. [020]; page 1, par. [003]; Fig. 3, 4; page 2, par. [014]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Flesner to include the

features of Budka because listing experts with their information provides users the necessary tools required to make knowledgeable decision making choices.

**As to claim 16:**

Flesner does not expressly disclose the limitation of:

server further comprises instructions adapted to allow the administrator to assign to the expert appropriate categories of service from the file of categories;

However, Budka discloses this limitation at least on page 3, par. [022]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Flesner to include the features of Budka because assigning experts to categories assist the user in easy retrieval of the desired information.

**As to claim 17:**

Flesner does not expressly disclose the limitation of:

server further comprises instructions adapted to allow the administrator to assign to the expert sub-categories of service from the file of sub-categories

However, Budka discloses this limitation at least on page 3, par. [022] (...categories within the hierarchy). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Flesner to include the features of Budka because assigning experts to sub-categories assist the user in the easy retrieval of the desired information.

**As to claim 18:**

Flesner does not expressly disclose the limitation of:

wherein the server further comprises instructions adapted to allow the administrator to activate any of the experts and change any experts' availability or area of expertise.

However, Budka discloses this limitation at least on page 3, par. [021]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Flesner to include the features of Budka because the management of expert's information is critical for keep information current and accurate to the user. 11.

13. Claims 13 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Flesner and Budka, as applied above, and further in view of Reid et al., (US 2004/0153428) ("Reid").

**As to claim 13:**

Flesner and Budka does not expressly disclose the limitation of:

a server further comprises instructions adapted to allow the administrator to add service categories to a list to be resident in the file of categories.

However, Reid discloses this limitation at least on page 1, par. [019]; page 2, par. [032]; page 5, par. [061]; Fig. 26; page 5, par. [065]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Flesner and Budka to include the features of Reid because providing service categories to the user assists in easy retrieval of the desired information.

**As to claim 14:**

Flesner and Budka does not expressly disclose the limitation of:

a server further comprises instructions adapted to allow the administrator to add service subcategories to a list to be resident in the file of subcategories

However, Reid discloses this limitation at least on page 4, par. [048] and [056].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Flesner and Budka to include the features of Reid because providing service subcategories to the user assists in easy retrieval of the desired information.

### **Conclusion**

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date of the advisory action is mailed, and any extension fee pursuant to 37 CFR §1.136(a) will be calculated from the mail date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is

(571) 270-3609. The examiner can normally be reached on Monday – Thursday  
9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the  
examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The  
fax phone number for the organization where this application or proceeding is  
assigned is (571) 270-4609.

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/Dante Ravetti/  
Examiner, Art Unit 3685  
Sunday, August 03, 2008

/Calvin L Hewitt II/

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Supervisory Patent Examiner, Art Unit 3685